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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,079	06/22/2001	Signe Erickson Varner	55821 (71699)	6574
21874 7590 03/19/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER DESANTO, MATTHEW F				
ART UNIT		PAPER NUMBER		
3763				
MAIL DATE		DELIVERY MODE		
03/19/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/888,079

**Applicant(s)**

VARNER ET AL.

**Examiner**

MATTHEW F. DESANTO

**Art Unit**

3763

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-35, 38, 41, 42, 44-47 and 49-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-35, 38, 41, 42, 44-47 and 49-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Drawings***

1. The drawings were received on 3/12/07. These drawings are accepted.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 23, 26, 27, 28, 31, 35, 38, 45-47, 49, 50, 51, 56, 58, 59, 60-63, 70 – 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Lo Russo (US 2002/133184).

Lo Russo discloses a method of performing surgery on the eyes with using an incision, wherein the device has a piercing member (258) and a cannula (214), wherein the piercing member pierces the eye and the cannula is advanced to the treatment site to remove a cataract or the like (Figure 4a, 4b and entire reference).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24, 25, 29, 30, 32-34, 41, 42, 44, 48, 52, 53, 54, 55, 57, 62, 64, 66, 67, 68-78, 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo Russo and further in view of Paques et al. (US Pub 2003/0171722) view of Bowman et al. (USPN 6,378,526).

Lo Russo discloses the claimed invention except for infusing medicament into the body and what specific therapeutic agents can be applied to the eye as well as the specific location of wherein the eye the method will be used.

Paques et al. discloses a method for treating an eye with a device comprising a piercing member (4) with an outer diameter less than 25 gauge (0053) allowing the puncture location to self-seal and having a flexible plastic tube therein (0087) to administer a therapeutic substance to the eye. The device is used to treat conditions such as vascular occlusion (0039) by advancing the device transconjunctively and piercing the sclera of the eye and delivering a therapeutic agent subretinally (Figure 1, 2, 3 and paragraph [0105]-[0113]). Paques et al. also teaches more specific methods of injecting fluid into the eye.

Bowman et al., teaches a device for delivery of a therapeutic agent such as steroids, genetic material, or pharmaceuticals to the eye.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to deliver follow the steps of Paques et al. when injecting fluid into the eye when performing retina surgery, as well as using several of the different therapeutic agents that are taught by Paques et al. and Bowman et al., since this is well known in the art to use different doses and medications depending on the procedure and treatment. The applicant specification also discloses several well known methods of treatment for the eye, which deal with therapeutic agents being infused into the eye (see page 1 and 2).

***Response to Arguments***

5. Applicant's arguments filed 3/12/07 have been fully considered and are persuasive. Therefore the past the 102 and 103 Rejections in view of Palasis et al. (USPN 6,969,371) are withdrawn because of the amendments and arguments given in the remarks section.
6. With regards to Lo Russo the examiner disagrees with the interpretation of the prior art and the claims. In the 102 Rejection in view of Lo Russo the examiner never states that Lo Russo discloses a method for delivering a treatment to the eye, but instead the examiner reads the last line of the claim to state "administering or aspirating" material from the eye, therefore Lo Russo reads the claimed invention since Lo Russo aspirates fluid and material from the eye. The examiner also disagrees with the interpretation of transconjunctively. According to the definition of conjunctiva, which the membrane that covers the sclera (which is the outside of the end), anytime you pierce the eye ball you would pierce the sclera, therefore since the prior art pierces the sclera, it teaches a method of pierces the conjunctiva [The examiner used Dictionary **conjunctiva** on Answers.com. The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2004 by Houghton Mifflin Company. Published by Houghton Mifflin Company.].

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW F. DESANTO whose telephone number is (571)272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3763

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew DeSanto  
February 26, 2008

/Matthew F DeSanto/  
Primary Examiner, Art Unit 3763